

REMARKS

Applicants request that the Office amend this application to make it in better form for appeal. Specifically, Applicants add new claims 110–116 to address the Examiner's comments and concerns in the Supplemental Examiner's Answer. Applicants submit that under 37 C.F.R. § 1.116(c) good and sufficient reasons why these amendments are necessary and were not earlier presented exist. Applicants have considered the very recent case *University of Rochester v. G.D. Searle & Co., Inc.*, No. 03-1304, slip op. at 17 (Fed. Cir. Feb. 13, 2004). *Rochester* holds that the standard for written description support of a composition claim or a method claim using that composition is the same. Applicants had previously believed and argued that the composition standard would not necessarily apply to method claims. The new standard in *Rochester* clarifies the rules for written description of method claims. Based on this development in the law, Applicants now wish to amend the claims, especially add new claims 110-116, in order to address the Examiner's written description rejection.

Support for the new claims may be found in the specification on page 6, lines 3-6; page 10, lines 7-8; page 17, lines 15-23; and page 54, line 34 through page 55, line 2. Minor amendments to claims 91, 92, 100, 101, 103 have been made to clarify the claimed invention and are supported on page 53, lines 6-11 and 26-32; page 31, lines 24-27; page 32, lines 11-14 and 22-33; page 33, line 2; and page 24, lines 17-24. No new matter has been added by way of this amendment.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicants submit that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all

of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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